

Appl. No. 09/852,432
Amendment Dated April 14, 2006
Reply to Office Action of December 14, 2005

REMARKS

Claims 1-19 are pending in this application. Claims 1, 2, 9, 12, and 18 have been amended. No new matter has been added. Favorable reconsideration and allowance of the standing claims are respectfully requested.

35 U.S.C. § 103(a) Rejection

Claims 1-19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over United States Patent Number (USPN) 6,266,776 to Sakai ("Sakai") and United States Patent Number (USPN) 5,483,656 to Opreescu et al. ("Opreescu"). Applicants respectfully traverse the rejection.

While Applicants disagree with the broad grounds of rejection presented in the Office Action, the independent claims have been amended in order to expedite prosecution on the merits. Claims 1, 9, 12 and 18 have been modified to clarify that the devices are "stored in a physical rack." Support for this language may be found in the Specification, page 4, line 1, for example. By way of contrast, both the Sakai reference and Opreescu reference are directed to computer systems such as a laptop computer and therefore do not describe any devices "stored in a physical rack." Consequently, Applicant respectfully submits that claims 1-19 represent patentable subject matter for at least this reason, and requests reconsideration and removal of the obviousness rejection.

Furthermore, with respect to the previous claim language, the Office Action has failed to meet its burden of establishing a *prima facie* case of obviousness. According to MPEP § 2143, three basic criteria must be met to establish a *prima facie* case of

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obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 706.02(j).

As recited above, to form a *prima facie* case of obviousness under 35 U.S.C § 103(a) the cited references, when combined, must teach or suggest every element of the claim. See MPEP § 2143.03, for example. Applicant respectfully submits that the Office Action has not established a *prima facie* case of obviousness because the cited references, taken alone or in combination, fail to teach or suggest every element recited in claims 1-19. Therefore claims 1-19 define over the Sakai reference and the Oprescu reference whether taken alone or in combination. For example, independent claims 1 and 18 recite the following language:

creating a modification signal, based on a change in said power level of said power supply, to modify an operating power level of at least one of said plurality of devices from a first operating power level to a second operating power level, **said second operating level based on an amount of change in said power level and said priority factor.**

As correctly noted in the Office Action, the emphasized language is not disclosed by the Sakai reference. According to the Office Action, the missing language is disclosed by the

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Oprescu reference at Fig.2; col. 7, lines 6-10, 49-61; col.8, line 59 to col. 9, line 4.

Applicant respectfully disagrees.

The Oprescu reference fails to disclose the missing element of claims 1 and 18.

For example, the Oprescu reference at the given cite, in relevant part, states the following:

At 114, the power manager compares the priority of the power usage request with the priority of previously granted power usage requests. If devices are currently operating subject to a power usage request having a lower priority, the power manager revokes the previously granted power usage request thereby increasing the available power surplus sufficient to allow a grant of the new power usage request.

As indicated above, a device in need of power sends a power usage request to the power manager. The power manager responds to a power usage request from a given device arguably based on a priority level. By way of contrast, the claimed subject matter recites "said second operating level based on an amount of change in said power level and said priority factor." The Oprescu reference fails to disclose at least this language. For example, the Oprescu reference fails to describe "an amount of change in said power level" since the power manager is arranged to respond to a power usage request thereby obviating any need to respond to a "change in said power level." In another example, the Oprescu reference fails to describe multiple power operating levels, and therefore does not describe or have a need for a "second operating level." Therefore, the Oprescu reference fails to disclose, teach or suggest the missing language of claims 1 and 18. Consequently, the Sakai reference and Oprescu reference, whether taken alone or in

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combination, fail to disclose, teach or suggest every element recited in independent claims 1 and 18.

Furthermore, Applicant submits that even if the combination of the cited references were to teach or suggest every element of the claimed invention, without motivation to combine the cited references to arrive at the claimed invention, a rejection based on obviousness under 35 U.S.C. § 103(a) is improper. *See* MPEP § 2143.01, for example. The motivation to make the alleged combination must be found either in the cited references or in the knowledge generally available to a person of ordinary skill in the art. *Supra*. Possible sources for a motivation to combine references include: [use the appropriate argument unless all three apply] (1) the nature of the problem to be solved; (2) the teachings of the prior art, and (3) the knowledge of persons of ordinary skill in the art. The Office, however, cannot rely solely upon the level of skill in the art to provide the suggestion to make the alleged combination of cited references. *Supra*. Initially, the burden is on the Office to provide some suggestion that it is desirable to do what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *See* MPEP § 2142, for example.

Claims 1 and 18 also are patentable and non-obvious over the Sakai reference in view of the Opreescu reference, whether taken alone or in combination, because a rejection based on obviousness under 35 U.S.C. § 103(a) is improper without a motivation to combine the cited references. *See* MPEP § 2142, for example. The Sakai

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reference fails to discuss a "priority factor" or use of a "priority factor" in any context. Therefore, the Sakai reference clearly fails to provide the proper motivation to make the combination alleged by the Office. Similarly, the Oprescu reference also fails to provide the proper motivation to combine.

In the present case, the Office has failed to meet its initial burden to provide some suggestion or motivation that it is desirable to do what the Applicant has done. The Office also has failed to support its conclusion of obviousness by failing to present a convincing line of reasoning as to why a person of ordinary skill in the art would have found the claimed invention to have been obvious in view of the teachings of the cited references. Rather, the Office merely concludes that it would have been obvious to make the alleged combination without providing any reasoning at all as to why the alleged combination would have been desirable to a person of ordinary skill in the art. As discussed previously, a conclusion by the Office that the claimed invention is obvious, either because it is expressly or impliedly suggested in the cited references, must be supported by a convincing line of reasoning setting forth why a person of ordinary skill in the art would have found the claimed invention to have been obvious in view of the teachings of the cited references. *See* MPEP § 2142, for example.

Here, the Sakai reference and the Oprescu reference fail to teach or suggest, either expressly or impliedly, the desirability of making the alleged combination to arrive at the invention of claims 1 and 18. Nor do the cited references provide any motivation to make the alleged combination to arrive at the invention of claims 1 and 18. Furthermore, the Office does not set forth a clear line of reasoning or suggestion as to why it would have been desirable for a person of ordinary skill in the art to make the alleged

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combination of the Sakai reference and the Oprescu reference, to arrive at the invention of claims 1 and 18.

To establish a *prima facie* case of obviousness, all of the teachings of the cited references must be considered, even disclosures that teach away from the claimed invention. *See* MPEP § 2141.02. Furthermore, the proposed combination cannot render the cited references unsatisfactory for their intended purpose or change the principle of operation of a reference. *See* MPEP § 2143.01, for example. Thus, it is improper to combine references where the references teach away from their combination. *See* MPEP § 2145, for example.

Here, the Oprescu reference teaches away from making the combination alleged in the Office Action because priority levels are only used in response to a power usage request, and not “based on a change in said power level of said power supply” as recited in claims 1 and 18. Therefore, it is improper to make the combination of the Sakai reference and the Oprescu reference as alleged in the Office Action. Accordingly, Applicant respectfully submits for at least these reasons that claims 1 and 18 are non-obvious and patentable over the Sakai reference in view of the Oprescu reference, whether taken alone or in combination, and the obviousness rejection with respect to claims 1 and 18 should be withdrawn.

For at least the reasons given above, claims 1 and 18 are non-obvious and represent patentable subject matter in view of the cited references, whether taken alone or in combination. Accordingly, removal of the obviousness rejection with respect to claims 1 and 18 is respectfully requested.

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In addition, if an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is non-obvious. *See* MPEP § 2143.03, for example. Accordingly, removal of the obviousness rejection with respect to claims 2-8 and 19 is respectfully requested. Claims 2-8 and 19 are non-obvious and patentable over the Sakai reference and Oprescu reference, taken alone or in combination, at least on the basis of their dependency from claims 1 or 18. Applicant, therefore, respectfully requests the removal of the obviousness rejection with respect to these dependent claims.

Independent claims 9 and 12 recite features similar to those recited in claims 1 and 18. Therefore, Applicant respectfully submits that claims 9 and 12 are patentable over the Sakai reference in view of the Oprescu reference for reasons analogous to those presented with respect to claims 1 and 18. Accordingly, Applicant respectfully requests removal of the obviousness rejection with respect to claims 9 and 12. Furthermore, Applicant respectfully requests withdrawal of the anticipation rejection with respect to claims 10, 11, and 13-17 that depend from claims 9 or 12, and therefore contain additional features that further distinguish these claims from the Sakai and Oprescu references.

For at least the above reasons, Applicant submits that claims 1-19 recite novel features not shown by the cited references. Further, Applicant submits that the above-recited novel features provide new and unexpected results not recognized by the cited references. Accordingly, Applicant submits that the claims are not anticipated nor rendered obvious in view of the cited references.

Applicant does not otherwise concede, however, the correctness of the Office Action's rejection with respect to any of the dependent claims discussed above.

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Accordingly, Applicant hereby reserves the right to make additional arguments as may be necessary to further distinguish the dependent claims from the cited references, taken alone or in combination, based on additional features contained in the dependent claims that were not discussed above. A detailed discussion of these differences is believed to be unnecessary at this time in view of the basic differences in the independent claims pointed out above.

The Examiner is invited to contact the undersigned at 724-933-5529 to discuss any matter concerning this application.

Respectfully submitted,

KACVINSKY LLC

s/John F. Kacvinsky/s

John F. Kacvinsky, Reg. No. 40,040
Under 37 CFR 1.34(a)

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4500 Brooktree Road, Suite 102
Wexford, PA 15090

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